

**REMARKS:**

Upon entry of the present Amendment C, the claims pending in the present application are claims 1, 3, 5-16, and 20-21, of which claims 1 and 20 are independent. Claims 2, 4 and 17-19 have been canceled.

The above-identified Office Action has been reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment C is submitted. It is contended that by the present amendments, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

**Amendments Presented**

Independent claims 1 and 20 have been amended to further define aspects of applicant's invention, (e.g., defining components such as a memory portion that the IC tag comprises). Claims 1 has also been amended to incorporate the limitations of claim 2, now canceled. Further, claim 20 has been amended for minor editing. Claims 7-15 have each been amended to specify that the rewritable area of the memory portion of the IC tag includes the claimed records.

Applicant respectfully submits that all of the amendments put forth above are fully supported by the specification, do not add any new matter to the specification, and are patentably distinct over the applied references. Accordingly, applicant respectfully requests favorable consideration of the above amendments.

**Claim Objection**

In the Office Action (page 3, item 3), the Examiner objected to claim 20, because of a minor informality.

*Applicant's Response:*

Applicant has amended claim 20 to change “vehicle ID” to “motorcycle ID” as suggested by the Examiner. Therefore, applicant respectfully requests reconsideration and withdrawal of the objection of record.

**Double Patenting Rejection**

In the Office Action (page 2, item 2), the Examiner (provisionally) rejected claim 1 on the ground of nonstatutory double patenting over claims 1 and 8 of copending application (Appl. No. 10/801694, Pub. No. US 2004-0203360). The Examiner asserted that the subject matter claimed in the present application has been fully disclosed in the copending application.

*Applicant's Response:*

Applicant is filing a **Terminal Disclaimer** herewith relating to applicant's copending application (Appl. No. 10/801,694) in compliance with 37 CFR § 1.321, as suggested by the Examiner. Therefore, applicant respectfully requests reconsideration and withdrawal of the double patenting rejection of record.

**Claim Rejection – 35 USC 103**

In the Office Action (pages 2-3, item 5), the Examiner rejected claims 1-3 and 5-21 under 35 USC §103(a) as being unpatentable over Tamai et al. (US Patent No. 7,031,946; hereinafter, “Tamai”) in view of Calandruccio (US 5,955,965) or Takashima (US 6,352,045).

Regarding claims 1-3, 5-6, and 16-19, the Examiner asserted that Tamai discloses all of the features of the claimed invention (Fig. 15; col. 17, lines 16-48; reference to a “motorcycle” in col. 34, line 2) except for the exact location where the IC tag can be attached to the motorcycle. However, the Examiner continued that in her view, Calandruccio teaches an IC tag attached to a bicycle near the handlebar or the seat (Figs. 1-2, transponder 5 with power supply 9) and that

Takashima teaches a transponder tag 58 embedded in a lanyard member 54, formed from resin, near the handlebar of a watercraft (motorcycle). Given these (alleged) disclosures, the Examiner concluded that in her view, “[s]ince Tamai discloses the IC tag is very small, [the tag] can be attached to a variety of products of small sizes” (col. 33, lines 6-18) or “to a motorcycle or its component in the vehicle industry” (col. 34, lines 2-3), it would have been obvious as a matter of design choice “to attach the IC tag of Tamai . . . to the motorcycle at any component at any location” including the locations as claimed in the present application.

Regarding claims 7-15, the Examiner asserted that Tamai discloses “managing life cycle of a motorcycle using the IC tag to store all activities regarding manufacturing, distribution, sale, service, and collection/recycling stage (col. 18, lines 20-46, col. 33, line 19, col. 36, line 18), and that therefore in her view, the claimed invention would have been obvious.

Regarding claims 20-21, the Examiner asserted that Tamai also discloses a management system using the IC tag including a host server 60, a network (the Internet) 30, and a database 51 (Figs. 4-5) and that therefore in her view, the claimed invention would also have been obvious.

**Applicant’s Response:**

Upon careful consideration and in light of the above amendments to independent claims 1 and 20, applicant respectfully traverses the Examiner’s rejection and submits that all of the pending claims are patentably distinguished over the applied references, because the reference do not teaches or suggests the features claimed in the present application.

For example, applicant submits that unlike the IC tag 80 of Tamai, which is fully equipped with an internal power supply 203, the “transponder [58 of Takashima] has no internal power supply.” (Takashima, col. 4, lines 36-37). As for Calandrucchio, the transponder 5 has a separate *external* power supply 9 as shown in all of its figures. Further, the transponders of

Takashima and Calandruccio is not capable of data management or storage. Calandruccio does not disclose a memory unit for its transponder. While Takashima does, such memory pertains, if at all, to a reading device 94; Takashima also does not disclose a memory unit for its transponder. Additionally, applicant submits that the communication distance of the IC tag of Tamai is approximately 1 m or less – thereby making, for example, the tracking/recovery system of Calandruccio (through a call station) obsolete. (Tamai, col. 17, lines 24-25).

### **The Standard for Obviousness**

Regarding the Examiner’s asserted obviousness as a matter of design choice, applicant notes that while a mere rearrangement of parts may be held to be unpatentable, “[t]he mere fact that a [person skilled] in the art could rearrange the parts of the reference device to meet the terms of the claims . . . is *not by itself sufficient* to support a finding of obviousness.

The U.S. Supreme Court has recently held, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. . . . Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known. ***KSR v. Teleflex***, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (S.Ct.2007).

In this regard, the Examiner must provide a valid reason why he or she feels that it would be obvious to combine the elements of the cited references in the fashion claimed by applicant. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in ***KSR v. Teleflex***, *supra*.)

The U.S. Supreme Court has also stated that a factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U. S., at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”). *KSR v. Teleflex*, *supra*.

In light of these court rulings and MPEP rule, applicant respectfully submits that the Examiner’s assertion as to attaching the IC tag of Tamai to the handle and the seat, among other locations, is not correct. Calandruccio and Takashima shows their respective IC tags/transponders being mounted near the handlebar or seat of a bicycle (which includes a bicycle powered by electricity, in the locating system of Calandruccio) and watercraft (in the immobilization system of Takashima). However, neither reference otherwise provides a suitable motivation under the standard of MPEP §2144.04.

Tamai indicates that its IC tag is attached to “books, CDs, cloths or the like which are stored” in stacks and “to each wire [that] connect[ing] [office] computers and printers [where the wires are] embedded under the [office] floor.” (Tamai, col. 33, lines 6-18, as relied on by the Examiner). However, Tamai’s reference as to entirely-nonmetallic books and CDs are *irrelevant*, because in the present application, an IC tag is attached to the claimed locations on a motorcycle with multiple signal-reflecting metal parts, while still being readable. (Application, para. [0018]). As to Tamai’s reference to wires on the floor, the present application considers such location to be “*very inconvenient*.” (Application, para. [0015]: an IC tag near the chassis under the motorcycle body.) As to Tamai’s alleged reference to a “motorcycle,” Tamai in col. 34, lines 2-3 (also relied on by the Examiner), *merely* indicates that its IC tag may be attached to a “motorcycle” or vehicle component, *without ever disclosing or otherwise suggesting a*

*location*. Therefore, we believe that Tamai does not provide a motivation or valid reason to attach the IC tag at such locations as claimed in the present application.

As for Calandruccio, its anti-theft transponder/tag is “located within the bottom frame tube 3” and “the seat frame tube 13” with “a seat plate 16” (shown in Fig. 3) in order to conceal the tag. (Calandruccio, col. 3; lines 7-9, 13-14). In this regard, applicant submits that the “motivation or reason” for such location is *contrary* to that of the present application, wherein an IC tag is attached to a motorcycle as far away from a metal part as possible while still being readable.

As for Takashima, its immobilization transponder/tag is not attached to a handlebar of a watercraft – rather the (engine or motor) kill switch assembly 60 is mounted thereon – because an ignition switch is ordinarily found near the handlebar. For the same reason, Takashima also contemplates the kill switch assembly being mounted on an outboard motor. (Takashima, col. 4, lines 55-65). Again, applicant submits that this “motivation or reason” is entirely distinct from that of the present application.

Given these lack of motivation or reason in Calandruccio and Takashima to modify Tamai’s system, applicant respectfully submits that the Examiner’s § 103 rejection based on the asserted obvious matter of design choice is improper.

Similarly, applicant respectfully submits that the Examiner’s assertion as to the location of the IC tag based on the alleged small size of the tag is improper and thus, unfounded. To note, the Examiner asserted that while Tamai does not disclose the exact location of the IC tag on a motorcycle, it would be obvious to attach the tag anywhere on a motorcycle, because Tamai discloses the IC tag is small in size. Contrary to such assertion, applicant respectfully submits that a person skilled in the art, without more, would *not* rely on a (small) *size* of the IC tag to find

it obvious to attach the tag to such *locations* on a motorcycle as claimed in the present application – that is, a size, without more, is not a determining factor for location.

Further, applicant respectfully submits that the Examiner’s assertion that such locations (as claimed in the present application) are a simple (obvious) change from what she asserted to be disclosed Tamai, also cannot stand under the appropriate guidelines.

In this regard, applicant submits that in the present application, the element of resin material and the IC tag are located at a generally high position (at an instrument panel/gauge unit) in a motorcycle, and radio waves can easily reach the IC tag from an upper position during reading and writing processes. Again, these features are not “fairly suggested,” by any of the references or record such as, for example, by Tamai.

Specifically regarding independent claim 20 (and dependent claim 21), applicant submits that while Tamai discloses a Life Cycle Management System 10 that may appear to be similar to the claimed invention, Tamai’s system is significantly different from the claimed invention. As shown in Fig. 4, Tamai’s system includes (a plurality of) a subsystem 20, which is connected to the Internet 30. In Fig. 5, the subsystem 20 is shown in detail with four groups.

In the present application, “each vehicle manufacturer, vehicle dealer, repair and maintenance company, recycle company and water company . . . [uses the terminals 53, 54 to] access the host server 51 and the database 52 via the network 50.” (Application, para. [0069]; Fig. 6). However, such users in Tamai each have its own server and database as clearly shown in Fig. 4. Therefore, applicant submits that unlike those in the present application, such users in Tamai need not have individual user-access IDs to limit their access or even upon access authorization, to *selectively* extract information from the server/database.

Applicant submits that Tamai does not teach, suggest or disclose such user-access limitation with selective data retrieval/transmission as presently claimed in the present application. As amended, claim 20 recites (in relevant portion) that the claimed terminal comprises:

- a device for transmitting the ~~vehicle~~ motorcycle ID and an authorized access ID to the host server; and
- a device for receiving tag information transmitted from the host server in response to the ~~vehicle~~ motorcycle ID, the host server comprising:
  - a device for verifying the authorized access ID;
  - a device for searching the database by the ~~vehicle~~ motorcycle ID received from the terminal as a search key to selectively extract tag information corresponding to the ~~vehicle~~ motorcycle ID, as allowed by the authorized access ID; and
  - a device for transmitting the selectively extracted tag information to the terminal . . .

Tamai discusses “identification code” and “authentication” thereof; however, applicant submits that these are fundamentally different from the user-access ID (i.e., the “company ID” as described in paras. [0071]-[0073]) of the present application. Tamai’s identification code “uniquely identifies a radio IC tag” (Tamai, col. 17, lines 38-39) and thus, such code is analogous to the vehicle ID for each IC tag of the present application, not the user-access ID. Again, Tamai does not otherwise limit individual user-access – nor, even upon access authorization, to *selectively* extract information from the server/database.

Applicant notes that Tamai lists possible modifications to its system for use in a hospital setting. (Tamai, col. 32, lines 44-50). While this appears to be a user-access limitation, applicant submits that even this limitation is significantly different from the user-access limitation as claimed in the present application. In this context (of Tamai), a password is entered into the reader/writer, as stated above, and not the host server (through the terminal) as claimed in the present application. That is, once the password is entered in Tamai, the reader/writer interacts



only with the IC tag (although to gain access to different “stages” of the memory unit) without involving a server or database as claimed in the present application. (Tamai, col. 32, 47-50).

Based on the foregoing, applicant respectfully submits that the rejection of claims 1, 3, 5-16, and 20-21 under 35 USC §103(a) based on Tamai, Calandruccio, and Takashima has been overcome. Therefore, applicant respectfully requests reconsideration and withdrawal of the rejection of record, and allowance of the pending claims.

### **Conclusion**

For all of the above mentioned reasons, applicant requests reconsideration and withdrawal of the rejections of record, and allowance of all the pending claims. Applicant believes that the application is now in condition for allowance; therefore, a notice to this effect is earnestly solicited.

Entry of the present amendment after final under 37 CFR 1.116 is respectfully requested on the grounds that it raises no new issues for consideration by the Examiner, that it places the application in condition for allowance, and/or that it places the claims in better form for appeal.

If the Examiner is not fully convinced of the allowability of the claims now in the application, or feels that the prosecution of the application could be assisted by a telephone conference, applicant respectfully requests that the Examiner telephonically contact applicant's undersigned representative to expeditiously resolve any issues remaining in the prosecution of the application.

Favorable consideration is respectfully requested.

Respectfully submitted,

  
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6 November 2008

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